

**REMARKS****Status Of The Claims**

This is an Amendment and Reply to the Office Action mailed June 12, 2007, in which the following rejections were set forth: Claim 1 was provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 1 of copending U.S. Patent Application Serial No. 10/507,090 and apparently in view of published U.S. Patent Application No. 2001/0019004 of Sagane et al. ("*Sagane*"); Claim 1 was rejected under 35 U.S.C. 102(e) as being anticipated by *Sagane*; Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 0253482 ("*WO0253482*"); and Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *WO 0253482* in view of *Sagane*.

By this response, Claim 1 has been amended and no claims have been added or canceled. As such, Claim 1 is pending and reconsideration of the present application is respectfully requested.

**Nonstatutory Obviousness-Type Double Patenting Rejections**

The present application, as well as the pending U.S. Patent Application Serial No. 10/507,090 that is being relied upon to reject Claim 1 of the present application under nonstatutory obviousness-type double patenting, are commonly owned by the same assignee—Eisenmann Maschinenbau KG. Nevertheless, Applicant submits that in view of the claim amendments and accompanying remarks set forth below, amended Claim 1 is not obvious in view of Applicant's co-pending U.S. Patent Application Serial No. 10/507,090 in combination with *Sagane*. As such, reconsideration of the provisional rejection of Claim 1 is respectfully requested.

Applicant reserves the right to provide a Terminal Disclaimer to overcome the provisional rejection of Claim 1 at a later time.

**§ 102(e) Claim Rejections***Sagane*

Claim 1 stands rejected as being anticipated by *Sagane*, wherein it is alleged that *Sagane* discloses each and every element of Applicant's claim invention. In particular, the Office Action relies upon Figure 17 of *Sagane* to disclose the lack of a dripping zone between two treatment containers disposed immediately downstream of each other. Figure 17 however is a process chart—a pure principle presentation—referring to the utilization of floor conveyors (FC) and

overhead conveyors (HC) in prior art processes. See *Sagane*, paragraph 0004.

*Sagane*, in particular Figure 17, would not teach one of ordinary skill in the art to omit a dripping zone because it is most undesirable to carry off fluid from one bath to a subsequent station in order; otherwise the subsequent bath would be contaminated with fluid of the preceding bath. And *Sagane* contains no disclosure directed to avoiding such contamination.

Furthermore, if the subsequent station is a drying oven, there must be a dripping process before the entry into the drying oven in order to avoid unacceptable rings on the surface. Such rings would result from vaporization of fluid, e.g., if this fluid is water. These rings would lead to major disturbances in a subsequent varnishing process as are changes in colors.

With respect to some of the individual elements disclosed by *Sagane*, its rotational shaft 4 is equivalent to the “at least one swivel arm” of the present application. The Office Action however holds vertical arm 5 to be equivalent to this at least one swivel arm. Nonetheless, vertical arm 5 is not hingedly-coupled to the running gear—as required by amended Claim 1.

*Sagane* also does not exhibit mutually independently actuable drives for translational movement, i.e., the swiveling of the at least one swivel arm and of the holding device. That is, the drive for translational movement in *Sagane*’s first embodiment cannot be actuated independently from the rotation of rotational shaft 4. See e.g., *Sagane*, paragraphs 91-93. Moreover, rotation of shaft 4 is directly derived from a translational movement of carrier 3; thus, when translational movement is stopped, rotation is also stopped.

Referring to *Sagane*’s second embodiment—Figs. 9-13—rotation is limited to certain moveable portions 30 of the conveyor 2, at which translational movement is stopped (see paragraph 108) and rotation takes place. Obviously, there is no independence in actuating the drives involved. This is also true for *Sagane*’s third embodiment (see paragraph 119).

For at least the reasons set forth above, *Sagane* fails to disclose each and every element of Applicant’s amended Claim 1. As such, Applicant respectfully submits that amended Claim 1 is patentable and requests the rejection be removed and the claim allowed.

#### § 103 Claim Rejections

For prior art references to be combined to render obvious an invention under 35 U.S.C. § 103(a), there must be something in the prior art as a whole that suggests the desirability, and thus, the obviousness, of making the combination. Furthermore, hindsight is strictly forbidden

and it is impermissible to use the claims as a framework from which to pick and choose among individual references to recreate the claimed invention. It is well established that focusing on individual elements of the claimed invention, rather than on the invention as a whole, is not the proper test.

Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. The test for obviousness is not "obvious to try," but rather, whether the claimed invention as a whole, in light of all the teachings of the references in their entirety, would have been obvious to one of ordinary skill in the art at the time the invention was made. When the prior art fails to suggest the claimed invention, any reconstruction of the prior art to obtain the invention necessarily and inevitably requires impermissible hindsight. If selective combination of the prior art references is required to render the invention obvious, there must be some reason for the combination other than hindsight gleaned from the invention itself. That is, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.

Applicants respectfully submit that the Office Action has failed to point to a teaching within the relied upon prior art references that supports combination or modification resulting in Applicant's claimed invention; and as such, a *prima facie* case of obviousness has not been made.

*WO02053482*

Although *WO02053482* allegedly discloses many of the claimed elements of Applicant's Claim 1, similar to *Sagane*, *WO02053482* likewise fails to teach, disclose, or suggest omitting the dripping zones. Based on the reasoning provided above with respect to *Sagane*, omission of the dripping zones is not desirable and thus not at all obvious to one of ordinary skill. As such, neither *WO02053482* nor *Sagane*, alone or in combination, teach, disclose, or suggest each and every element of Applicant's amended Claim 1. Applicant therefore respectfully submits that amended Claim 1 is patentable and requests the rejection be removed and the claim allowed.

*WO02053482 In View Of Sagane*

*Sagane* and *WO02053482* have each been individually addressed above and have further been shown as failing to disclose, teach, and/or suggest configuration of directly adjacent

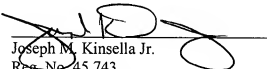
treatment tanks without a dripping zone positioned there between. Furthermore, no obvious reason has been provided from within either reference, e.g., to minimize the space requirements of the apparatus, to disclose such a configuration. Because the combination of relied upon prior art references fails to teach, disclose, or suggest each and every element of Applicant's amended Claim 1, Applicant respectfully submits that amended Claim 1 is patentable and requests the rejection be removed and the claim be allowed to issue.

### **CONCLUSION**

In view of the above amendments and remarks, Applicant respectfully requests that all rejections be removed and all pending claims be passed to issue. Applicant believes that no additional fees are required, however if any fees are required, they may be paid out of our Deposit Account No. 50-0545.

Respectfully Submitted,

Dated: September 11, 2007

  
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### **CERTIFICATE OF FIRST CLASS MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22314-1450 on September 11, 2007.

  
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